APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,370	02/06/2004	Robert M. Schumacher	8285-670	1908

757   7590   08/19/2008
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EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
08/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/773,370	SCHUMACHER ET AL.
	Examiner	Art Unit	
	JOSHUA D. CAMPBELL	2178	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>12 May 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>65-96</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>65-96</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Response to Election / Restriction

filed on 5/12/2008.

2.   Claims 65-96 are pending in this case. Claims 65 and 73 are independent

claims.

3.   The rejection of Claims 65-80 under 35 U.S.C. 102(b) as being anticipated by

Ernst, Warren, Using Netscape (hereinafter Ernst), published March 23, 1995, QUE

Corporation, pages 1-3, 23-59, 264-270 in view of "Keyboard Shortcuts in Netscape

Browser" (hereinafter Keyboard Shortcuts), Web site:

<http://www.netscape.ca/browser/netscape8/help/en/shortcuts.html>, copyright 1994-

2005, downloaded 4/6/2007 (used in support of Official Notice) has been withdrawn, a

new grounds of rejection has been applied.

Election/Restrictions

4.   Applicant's election with traverse of Species I in the reply filed on 5/12/2008 is

acknowledged. The traversal is found to be persuasive. The requirement for

restriction/election has been removed and claims 65-96 are pending.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 81-84 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Any claim containing a negative limitation

which does not have basis in the original disclosure should be rejected under 35 U.S.C.

112, first paragraph, as failing to comply with the written description requirement. The

mere absence of a positive recitation is not basis for an exclusion. In this case, the

negative limitations recited in claims 83 and 84, which did not appear in the specification

as filed, introduce new concepts and violate the description requirement of the first

paragraph of 35 U.S.C. 112. The express exclusion of certain elements implies the

permissible inclusion of all other elements not so expressly excluded. This clearly

illustrates that such negative limitations do, in fact, introduce new concepts (See Ex

parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff 'd mem., 738 F.2d 453 (Fed. Cir.

1984)).

        For the purposes of the advancement of prosecution, the claims will be

interpreted as they are written, however this does not remove the validity of the rejection

and proper correction is still required.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9.   Claims 65-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over

DynaText (as shown by "EBT Workshop Description: Introduction to Electronic

Publishing with DynaTag and DynaText," cited by applicant as being available October

20, 1995, found in the IDS filed on 12/20/2006) in view of Swonk (US Patent Number

5,867,729, issued February 2, 1999).

      Regarding independent claim 65, DynaText discloses the use of a browser to

view web information, which allows the user the ability to use queries to search for any

portion of web information containing a specific attribute, piece of content (character,

symbol, etc.), tagname, etc. (Section titled "Introduction to DynaTag/DynaText

Publishing" and Section titled, "DynaText Queries," including the section titled, "Binding

Query Forms" of DynaText). DynaText discloses displaying a portion of web

information as a result of performing the search and obtaining a result (Section titled

"Introduction to DynaTag/DynaText Publishing" and Section titled, "DynaText Queries,"

including the section titled, "Binding Query Forms" of DynaText). DynaText also

discloses the ability to bind queries to function elements in order to store custom

searches (Section titled "Introduction to DynaTag/DynaText Publishing" and Section

titled, "DynaText Queries," including the section titled, "Binding Query Forms" of

DynaText). DynaText does not explicitly disclose that performing of said search

functions are a result of the user pressing keys corresponding to the search functions.

However, Swonk discloses the ability to bind functions (such as the query function of

DynaText) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing

specific functions to be performed when the user presses the keys that the functions

have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk

discloses that the Function Key combinations may all have different functions bound to

them (in the case of the teachings of DynaText, different function elements having

different queries) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to have

combined the teachings of DynaText with the teachings of Swonk because it would

have allowed for increased usability for users with no pointing device available.

    Regarding dependent claim 66, DynaText does not explicitly disclose that

performing of said search functions are a result of the user pressing keys corresponding

to the search functions or that the keys are arranged in a row. However, Swonk

discloses the ability to bind functions (such as the query function of DynaText) to the

Function Key combinations (i.e. F1-F12 which exist in a row) on a keyboard, thus

allowing specific functions to be performed when the user presses the keys that the

functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk).

Swonk discloses that the Function Key combinations may all have different functions

bound to them (in the case of the teachings of DynaText, different function elements

having different queries) (Figure 4 and column 10, lines 22-54 of Swonk). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of DynaText with the teachings of Swonk because it

would have allowed for increased usability for users with no pointing device available.

Regarding dependent claims 67-70, DynaText discloses the use of a browser

to view web information, which allows the user the ability to use queries to search for

any portion of web information containing a specific attribute, piece of content

(character, symbol, etc.), tagname, etc. with the exclusion of other web information

(Section titled "Introduction to DynaTag/DynaText Publishing" and Section titled,

"DynaText Queries," including the section titled, "Binding Query Forms" of DynaText).

DynaText discloses displaying a portion of web information as a result of performing the

search and obtaining a result regardless of what was previously being displayed

(Section titled "Introduction to DynaTag/DynaText Publishing" and Section titled,

"DynaText Queries," including the section titled, "Binding Query Forms" of DynaText).

DynaText also discloses the ability to bind queries to function elements in order to store

custom searches (Section titled "Introduction to DynaTag/DynaText Publishing" and Section titled, "DynaText Queries," including the section titled, "Binding Query Forms" of DynaText). DynaText does not explicitly disclose that performing of said search functions are a result of the user pressing keys corresponding to the search functions. However, Swonk discloses the ability to bind functions (such as the query function of DynaText) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the teachings of DynaText, different function elements having different queries) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of DynaText with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

Regarding dependent claims 71 and 72, DynaText is installed and used on a computer with a mass storage device (to store the DynaText program and the created documents) and display (for the user to view the documents) (Section titled "Introduction to DynaTag/DynaText Publishing" and Section titled, "DynaText Queries," including the section titled, "Binding Query Forms" of DynaText).

Regarding dependent claims 81 and 83, DynaText discloses the use of a browser to view web information, which allows the user the ability to use queries to search for any portion of web information containing a specific attribute, piece of content

(character, symbol, etc.), tagname, etc. (Section titled "Introduction to

DynaTag/DynaText Publishing" and Section titled, "DynaText Queries," including the

section titled, "Binding Query Forms" of DynaText). DynaText discloses displaying a

portion of web information that is not a subset of a larger scrollable area and

independently of scrolling a result of performing the search and obtaining a result

regardless of what was previously being displayed (Section titled "Introduction to

DynaTag/DynaText Publishing" and Section titled, "DynaText Queries," including the

section titled, "Binding Query Forms" of DynaText). DynaText also discloses the ability

to bind queries to function elements in order to store custom searches (Section titled

"Introduction to DynaTag/DynaText Publishing" and Section titled, "DynaText Queries,"

including the section titled, "Binding Query Forms" of DynaText). DynaText does not

explicitly disclose that performing of said search functions are a result of the user

pressing keys corresponding to the search functions. However, Swonk discloses the

ability to bind functions (such as the query function of DynaText) to the Function Key

combinations (i.e. F1-F12) on a keyboard, thus allowing specific functions to be

performed when the user presses the keys that the functions have been assigned to

(Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key

combinations may all have different functions bound to them (in the case of the

teachings of DynaText, different function elements having different queries) (Figure 4

and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to have combined the teachings of

DynaText with the teachings of Swonk because it would have allowed for increased

usability for users with no pointing device available.

Regarding dependent claims 85-87, DynaText discloses the use of a browser

to view web information, which allows the user the ability to use queries to search for

any portion of web information containing a specific attribute, piece of content

(character, symbol, etc.), tagname, etc. (Section titled "Introduction to

DynaTag/DynaText Publishing" and Section titled, "DynaText Queries," including the

section titled, "Binding Query Forms" of DynaText). DynaText discloses displaying a

portion of web information as a result of performing the search and obtaining a result

(Section titled "Introduction to DynaTag/DynaText Publishing" and Section titled,

"DynaText Queries," including the section titled, "Binding Query Forms" of DynaText).

DynaText also discloses the ability to bind queries to function elements in order to store

custom searches (Section titled "Introduction to DynaTag/DynaText Publishing" and

Section titled, "DynaText Queries," including the section titled, "Binding Query Forms" of

DynaText). DynaText does not explicitly disclose that performing of said search

functions are a result of the user pressing keys corresponding to the search functions.

However, Swonk discloses the ability to bind functions (such as the query function of

DynaText) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing

specific functions to be performed when the user presses the keys that the functions

have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk

discloses that the Function Key combinations may all have different functions bound to

them (in the case of the teachings of DynaText, different function elements having

different queries) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of DynaText with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

 Regarding dependent claims 91, 92, and 95, DynaText does not explicitly disclose that performing of said search functions are a result of the user pressing keys corresponding to the search functions or that the keys are arranged in a row. However, Swonk discloses the ability to bind functions (such as the query function of DynaText) to the Function Key combinations (i.e. F1-F12 which are at least three buttons and are the top row of keys) on a keyboard, thus allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the teachings of DynaText, different function elements having different queries) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of DynaText with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

 Regarding independent claim 73 and dependent claims 74-80, 82, 84, 88-90, 93, 94, and 96, the claims incorporate substantially similar subject matter as claims 65-72, 81, 83, 85-87, 91, 92, and 95. Thus, the claims are rejected along the same rationale as claims 65-72, 81, 83, 85-87, 91, 92, and 95.

Response to Arguments

10.   Applicant's arguments with respect to claims 65-96 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
August 13, 2008